



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,440	02/02/2004	Mitsunori Hirano	2870-0273P	8904

2292 7590 11/21/2005

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
----------	--------------

1752

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,440

Applicant(s)

HIRANO ET AL.

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) 12-15 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This is in response to Papers filed on 07 October 2005. Applicants arguments are found to be convincing. The rejections in the Office action mailed on 07 April 2005 are withdrawn.

I. Claims 1-8 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Sudo et al (5,424,170).

Sudo et al disclose and teach a silver halide photographic material comprising a support having thereon (1) a silver halide emulsion layer containing (a) silver halide grains of 40% or more silver bromide and being spectrally sensitized with (b) a compound being read on the general formula I as elected, (c) an organic polymer and (d) inorganic particles and (2) a hydrophilic colloid layer. The material contains a hydrazine containing compound in amount of from 0.000 000 5 to 0.5 mol per mol of silver. A coating silver amount of less than 3.0 g/m². The material contains a conductive layer having an ion conductive polymer and inorganic particles. Please see the whole disclosure of the reference, especially at the general formula (I) and its compounds on col.2:57to 51:54, under title "formula 1" line 2 on col.60, first spectrally sensitizing dye on col.61, col.66:20-21 and 42 to

Art Unit: 1752

68 with compound “RD-2” and col.73 under title “Formula (2), lines 2 and 3 and col.74:4-6.

Sudo et al disclose and teach conductive layer(s) comprising inorganic metal oxide particles and ion conductive polymer on one side of the support but do not specify the property of “surface resistivity...” as that in claims 4 and 6. For a property of a material, it is allowed to request and require applicants to show a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Morishima et al disclose and teach the chemical structure of the spectrally “Sensitizing Dye-1” being read within the general formula I as claimed but do not specify the property of “dissolved in water...” as that in claim 8. For a property of a material, it is allowed to request and require applicants to show a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Since Sudo et al are reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Morishima et al.

II. Claims 4, 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudo et al. (5,424,170) considered in view of Morishima et al (5,994,040).

Sudo et al disclose and teach a silver halide photographic material comprising a support having thereon (1) a silver halide emulsion layer containing (a) silver halide grains of 40% or more silver bromide and being spectrally sensitized with (b) a compound being read on the general formula I as elected, (c) an organic polymer and (d) inorganic particles and (2) a hydrophilic colloid layer. The material contains a hydrazine containing compound in amount of from 0.000 000 5 to 0.5 mol per mol of silver. A coating silver amount of less than 3.0 g/m². The material contains a conductive layer having an ion conductive polymer and inorganic particles. Please see the whole disclosure of the reference, especially at the general formula (I) and its compounds on col.2:57to 51:54, under title “formula 1” line 2 on col.60, first spectrally sensitizing dye on col.61, col.66:20-21 and 42 to 68 with compound “RD-2” and col.73 under title “Formula (2), lines 2 and 3 and col.74:4-6.

Sudo et al disclose and teach the chemical structure of the spectrally “Sensitizing Dye-1” being read within the general formula I as claimed but do not specify the property of “dissolved in water...” as that in claim 8. For a property of a material, it is allowed to request and require applicants to show a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Sudo et al disclose and teach a conductive layer containing inorganic metal oxide particles and ion conductive polymer on one side of the support but do not specify the property of “surface resistivity...” as that in claims 4 and 6. It is reasonable to consider it to be inherent since the conductive layer contains the ion conductive chemical ingredients in the absence of convincing evidence to the contrary. For a property of a material, it is allowed to request and require applicants to show a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

However, Morishima et al also disclose, teach and suggest another conductive composition comprising an ion conductive polymer and inorganic particles for the advantage of an anti-static benefit on col.187:60 to 188:3, 199:40-50.

Sudo et al disclose, teach and suggest an under coating layer in between a support and a silver halide light sensitive emulsion layer but do not specify its chemical ingredient as that in claim 9. However, Morishima et al disclose, teach and suggest that there is a gelatin containing undercoat layer in between a support and a silver halide light sensitive emulsion layer for the advantage of obtaining an adhesive in between the layers on col.197:41-43.

Art Unit: 1752

Since the above references are all related to silver halide photographic materials, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite a conductive layer from Morishima et al for a reasonable expectation of obtaining an anti static benefit and use or cite a gelatin under layer in between a support and a silver halide light sensitive emulsion layer for a reasonable expectation of obtaining an adhesive benefit in between the layer as disclosed, taught and suggested in Morishima et al.

III. Applicants arguments filed on 07 October 2005 have been considered and are found to be convincing. Accordingly, the rejections in the Office action mailed on 07 April 2005 are withdrawn. However, the above rejections use new primary reference with respect to Sudo et al. (5,424,170)

IV. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

Art Unit: 1752

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
16 November 2005

HOA VAN LE
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive, flowing style.